REMARKS

The Specification has been amended to correct typographical errors and inadvertent terminology errors so that the terminology accurately reflects what is shown in the drawings. Specifically, the word "concave" has been changed to –convex-- in a number of places (as noted by the Examiner with regard to claim 20). Also, the word "ridges" replaces –recesses-- to bring the description into accord with the drawings. Applicant submits that no new matter has been added.

The Examiner rejected claim 20 under 35 U.S.C. 112, second paragraph as being indefinite. Applicant has amended claim 20 in accordance with the Examiner's comment to change "concave" to --convex-- to bring the claim into accord with the drawings.

The Examiner rejected claims 18 and 26-34 under 35 U.S.C. 102(b) as being anticipated by Nelson (U.S. Patent 5,613,342).

In contrast to the cited references (discussed further below), Applicant's invention is related a method of making and attaching molded elongated strips, most preferably those formed by batch cast molding, to provide a great variety of surface features. Batch cast molding is in essence pouring a molding compound into a mold, letting it cure, and removing it from the mold. This process is clearly distinct from extrusion and, as noted, permits creation of a wide variety of surface features, which may be quite intricate. Such surface features cannot be found in the typical elongated edges formed by extrusion or routers. Extrusion may create an elongated pattern which runs parallel to the length of an item, but not otherwise. None of the cited references teaches an elongated strip that was batch cast molded, that has ridges or recesses extending transverse to the length of the strip or that includes one three-dimensional pattern superimposed over a portion of another. Nor do they teach patterns that repeat along the elongated direction of the strips.

As just noted and as further detailed below with regard to the 103(a) rejections, Applicant's invention is clearly distinct from Nelson. To that effect, claim

18 has been amended to recite an elongated molded strip having an exposed outer surface defining a non-extrudable shape. As discussed below, none of the cited references teaches or suggests this limitation. Nelson simply shows an outer surface which is flat or includes a beveled edge with no other patterning. These outer shapes are easily extrudable. Thus, Applicant submits that claim 18 is allowable and that claims 26-34 are allowable as depending from an allowable claim. (In addition, Morgan et al. and Raggio each disclose only outer surface shapes which are also easily extrudable.)

The Examiner rejected claims 19-25 under 35 U.S.C. 103(a) as being unpatentable over Nelson '342 in view of Raggio (U.S. Patent 2,297,072) and Morgan et al. (U.S. Patent 2,717,187).

The Examiner initially has the burden of factually supporting a *prima facie* conclusion of obviousness, which then shifts the burden of providing evidence for arguments to the Applicant who may submit additional evidence of non-obviousness in order to overcome the Examiner's rejection. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation to combine the references, the three possible sources of which are the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. MPEP 2143.01, citing In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998). Second, there must be a reasonable expectation of success in combining the references in order for it to be proper to combine them. MPEP 2143.02, citing In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As discussed in detail below, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness.

Nelson '342 teaches construction of a furniture edge wherein a side molding 14 is connected to counter top 10 or the like at the outer edge thereof. One of the key aspects of Nelson's invention is the manner in which the side molding 14 is

connected to counter top 10. Importantly, Nelson teaches a glue channel or space (such as at 48 or 54) whereby excess glue has a place in which to be retained without flowing out from between molding 14 and counter top 10 and making a mess and creating additional material which must be removed in one manner or another. In short, Nelson teaches an apparatus and method for gluing a side molding to a counter top and the like, and gluing is the only manner in which Nelson teaches or suggests the connection of the two elements.

Raggio teaches elongated banding 8 wrapped around a desk top or the like and held on by a strap 12, which is under tension and connected at either end to form a closed loop around the edge of the desk and the banding 8. Raggio thus offers a way to hold an attachable edging without the use of other fasteners or adhesives. As stated at Column 3, lines 54-58, "It is also important to note that my improved banding for a desk top or the like is held firmly onto the desk top by compression formed by tension on the strap 12 during the tightening of the same." This the sole manner in which Raggio teaches or suggests holding banding 8 onto the desk top. Raggio also teaches the use of rounded corners which "enable the strap 12 to be tightly drawn in groove 11 around the outside of banding 8 in a smooth manner to prevent injuring the material of the banding or otherwise disrupting or marring the band or the desk top, as might occur if the table top edge were longitudinally straight and the corners were square." (Col.3, lines 4-11). Raggio further teaches a pair of spaced ridges 9 and 10 which extend longitudinally along the banding, parallel with the banding along its longitudinal length. Metal strap 12 is disposed in a groove 11 between ridges 9 and 10 and thus precludes other ridges extending outwardly from groove 11. Groove or recess 11 also extends the full length of banding 8 and is parallel to banding 8 along its length.

Applicant submits that there is no suggestion or motivation to combine Nelson and Raggio. As noted above, Nelson teaches a method of gluing a side molding to a counter top and the like, while Raggio teaches holding a side banding surrounding a desk top thereon by a strap under tension. The Nelson invention relates to attaching a side molding to a countertop edge with glue and solves the

problem of the overflow of excess glue in this context. As discussed above, Nelson relates only to glue-attached molding. Raggio holds banding to the desk top edge only by a strap under tension wrapped around the banding. Each of the inventions includes a method of attaching side molding or banding to the edge of a piece of furniture or the like. Thus, each has solved the problem of such attachment and there is no reason to look to the other to solve the same problem. Quite simply, neither of the two inventions provides a motivation to combine the two. Using the Raggio method instead of the Nelson method, or vice versa, would not be combining references to gain an advantage, but rather simply replacing one with the other.

In addition, using the method of Raggio could be detrimental to the structure of Nelson. The side molding 14 of Nelson provides a finished and possibly decorative surface. Wrapping a strap under tension would create compression around the Nelson molding which would (1) likely damage the surface and (2) disrupt the smooth alignment between molding 14 and top skin 18 by inward movement of molding 14 or by outward movement of molding 14 along the edges thereof in reaction to the adjacent inward compression in the central portion of molding 14. As noted above, Raggio provides rounded corners on the desk to prevent similar damage. Thus, Raggio teaches away from the the use of square corners, as is the case with most countertops, and as would be common with the method of Nelson. In addition, any decorative aspect on the outer surface of molding 14 would be covered up by the strap of Nelson.

Moreover, the method of Raggio would not work in the case where a counter top or the like did not have a completely open outer circumference. That is, a counter top extending from a wall or other structure would not permit a banding or strap to surround the edge thereof, thus precluding the ability to use the Raggio method altogether. Raggio clearly teaches away from use of the banding/strap method on anything which cannot be surrounded by the banding and strap.

Applicant thus submits that there is no motivation to combine Nelson and Raggio nor any reasonable expectation of success in combining them and that

claims 19-25 cannot be properly rejected over Nelson in view of Raggio so that the rejection should be withdrawn. In addition, as noted above, claim 18 has been amended to recite an elongated molded strip having an exposed outer surface defining a non-extrudable shape. Neither Nelson nor Raggio teach or suggest this limitation even if the two references are combined. As claims 19-25 depend directly or indirectly from claim 18, Applicant thus submits that claims 19-25 are allowable as depending from an allowable claim.

Morgan et al. teach a method for connecting wood finishing strips 15 to a table top having a decorative plastic laminate upper surface (plastic sheet 13) connected to a center core 10 of wood. The method includes forming an inwardly-downwardly extending bevel from the top to the bottom of the table top and a complementary bevel on the inner surface of finishing strips 15 and attaching finishing strip 15 to the table top at the respective beveled edges. The finishing strip 15 extends above and below the table top after this attachment. The upper portion is then beveled downwardly-outwardly from the top of the table, the bevel extending through a small edge portion of the upper plastic sheet 13 while avoiding exposure of center core 10. Thus, the focus of the invention is to create wood finishing strips harmonizing with the upper plastic sheet 13. As a result, Morgan et al. teach a elongated strip having a wood grain pattern on the surface. Morgan et al. further teach an outwardly curved or angled surface forming a shape which is easily extrudable. However, Morgan et al. fail to teach the intricate types of patterns possible with the method of Applicant's invention, as reflected in the amended claims and the new claims.

As detailed above in relation to Nelson and Raggio, Morgan et al. and Raggio cannot properly be combined for similar reasons. That is, each already teaches a method of attachment and thus the combination of the two is actually one method of attachment replacing the other. Further, as noted above in more detail, a band under tension would cause damage to the wood strips of Morgan et al. (most particularly at the corners) and also cover the wood grain which is a main focus of Morgan et al. Further, the weakness of wood due to the grain would be particularly

susceptible to damage by such compression, especially when using the relatively thin strips of wood inherent with such siding. Raggio even particularly notes that "Among the objects of my invention is to provide improved banding for the tops of desks and other furniture which . . . eliminates the need of wood banding thus saving the work and expense of steaming, cutting and weakness as to grain in wood." (See Col. 1, lines 6-16). Thus, Raggio specifically addresses eliminating wood banding, one of the particular reasons being the weakness of wood due to the grain thereof. Applicant submits that Nelson teaches away from use on the wood strips of Morgan et al., that there is no reasonable expectation of success in combining the two references and that the two references fail to teach or suggest the amended claim limitations even if combined.

Applicant submits for the above reasons that claims 19-25 are allowable over Nelson in view of Raggio and Morgan et al. Further, as noted above, none of the references teach or suggest the limitations of amended claim 18, which recites an elongated molded strip having an exposed outer surface defining a non-extrudable shape. Applicant thus submits that claims 19-25 are allowable as depending from an allowable claim. Claim 19 has been amended to delete language the substance of which has been incorporated into claim 18, but is otherwise unchanged. As noted above, claim 20 has been amended to overcome the 112 rejection, but is otherwise unchanged. Claims 21-25 are original.

Applicant has added new claims 35-52 and submits that each of these is allowable as depending from an allowable claim, as noted above and as otherwise noted below.

Applicant reemphasizes that Nelson and Raggio cannot be properly combined, as they teach away from one another. The same is true of Raggio and Morgan et al. Applicant applies this argument to all new claims to which it is purtenant. In addition, none of the references alone or in combination teach any of the new claim limitations, as further noted below.

Regarding claim 35, none of the cited references teach or suggest an elongated molded strip with an outer surface defining a first three-dimensional

pattern superimposed over a portion of a second distinct three-dimensional pattern. Each of the cited references show siding strips with outer surfaces that are flat, beveled, or rounded in simple fashions and at best show a single three-dimensional pattern.

Regarding claim 36, none of the cited references show a repeating pattern along the longitudinal length of a siding strip. Nelson, Raggio and Morgan et al. show a simple extrudable shape that remains the same over the entire length of the strip. Morgan et al. may be considered to disclose a wood grain pattern, but this is clearly not a repeating pattern.

Regarding claim 37, none of the cited references teaches or suggests a ridge tranverse to the elongated direction of the strip, as discussed above.

Regarding claim 38, similar to claim 37, none of the cited references teaches or suggests a recess tranverse to the elongated direction of the strip, as discussed above.

Regarding claim 39, none of the cited references teaches or suggests cutting an overhang of a planar protective coating which overhangs the horizontal deck and the elongated molded strip (or other such siding) so that the vertical edges of the coating and the deck align; nor do they teach or suggest positioning the coating behind the molded strip.

Regarding claim 40, the comments with regard to claims 37 and 38 apply.

Regarding claim 41, the argument concerning claim 36 applies.

Regarding claim 42, the cited references do not teach or suggest first and second distinct three-dimensional patterns on siding having either a transverse ridge or recess.

Regarding claim 43, the argument of claim 35 applies.

Regarding claim 44, the argument of claim 39 applies.

Regarding claim 45, the step of batch cast molding an elongated strip is not taught or suggested by any of the cited references. Batch cast molding is a preferred manner in which to make the type of molding Applicant has invented, that

is, molding having far more intricate patterns than that disclosed in the prior art, as discussed above.

Regarding claim 46, the argument concerning claims 37 and 38 applies.

Regarding claim 48, the argument concerning claim 36 applies.

Regarding claim 49, the argument concerning claim 37 applies.

Regarding claim 50, the argument concerning claim 38 applies.

Regarding claim 51, the argument concerning claim 35 applies.

Regarding claim 52, the argument concerning claim 39 applies.

In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal notice of allowability for the claims. Please call the undersigned attorney if any questions remain after this amendment.

Respectfully submitted at Canton, Ohio this 5TH day of November, 2003.

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CERTIFICATE OF MAILING

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Karina A. Butler

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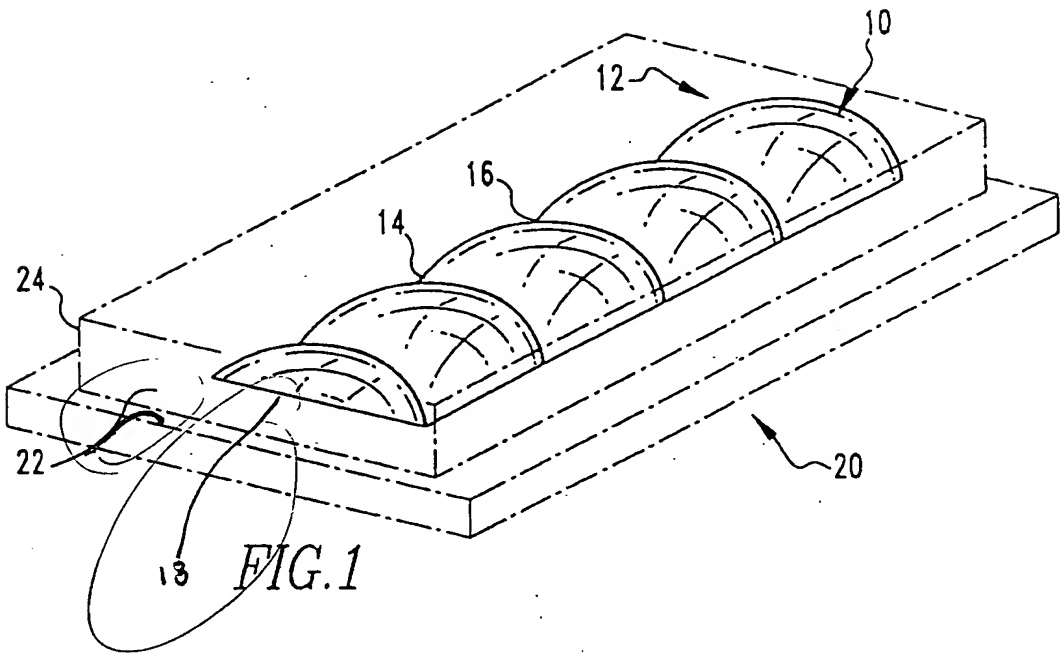

FIG.1

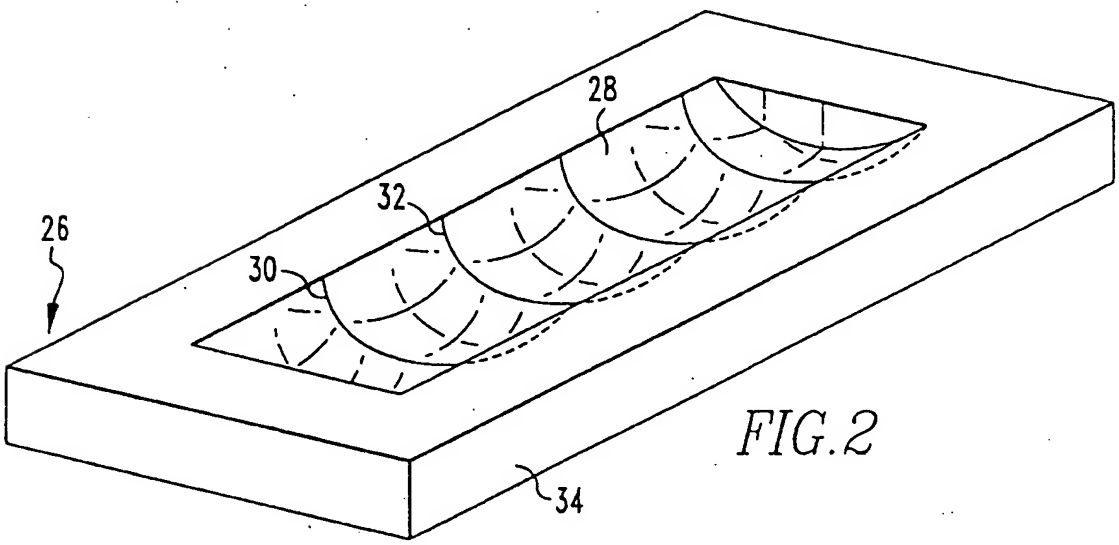

FIG.2

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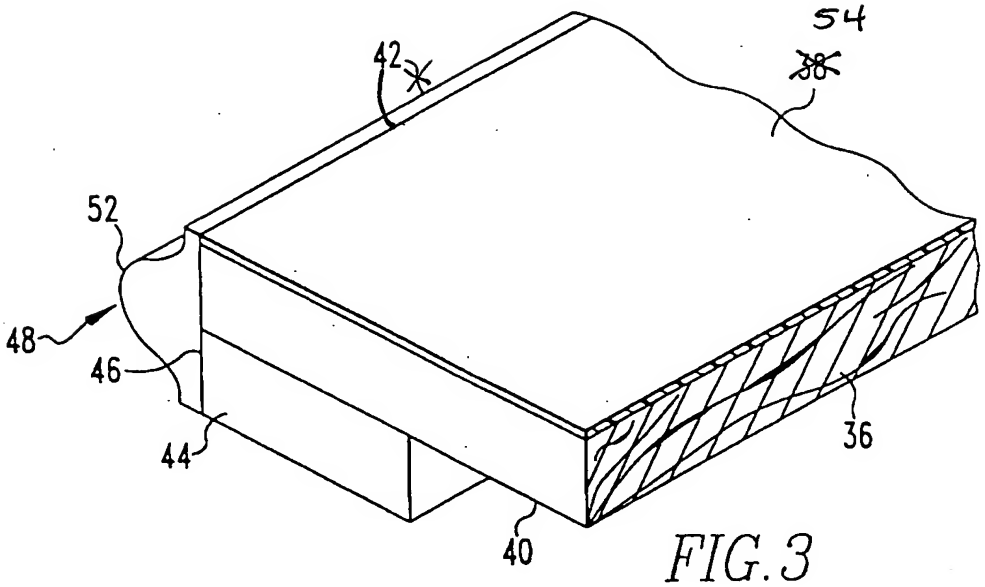

FIG.3

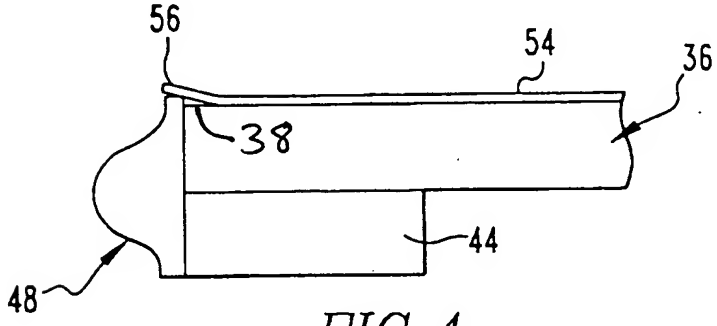

FIG.4

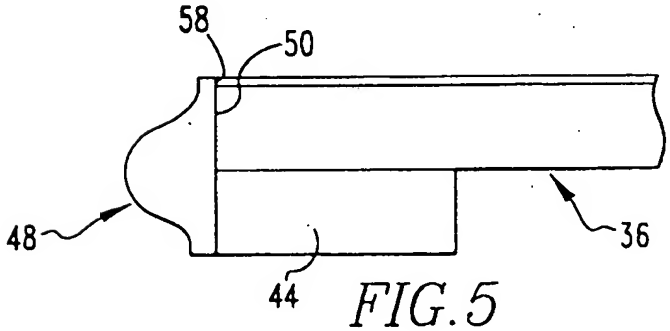

FIG.5

"Annotated Marked-up Drawings"

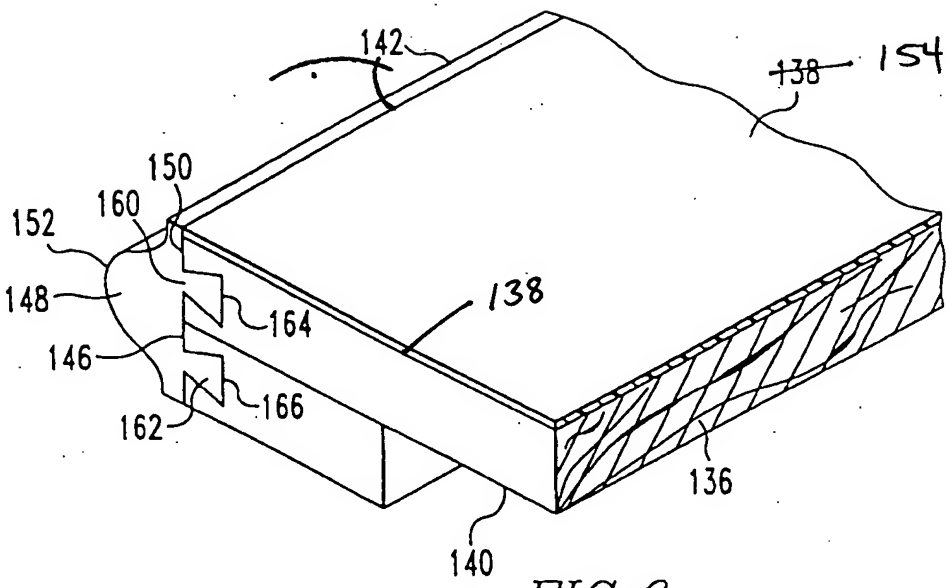

FIG. 6

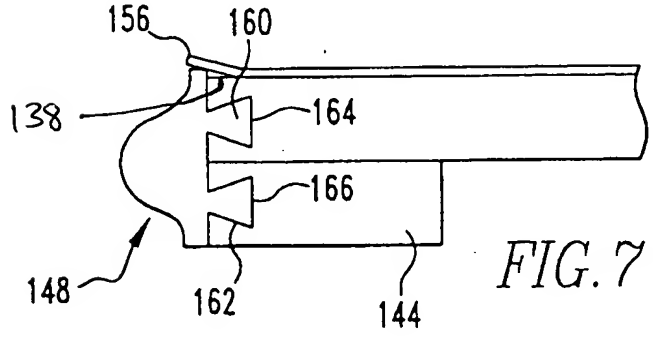

FIG. 7

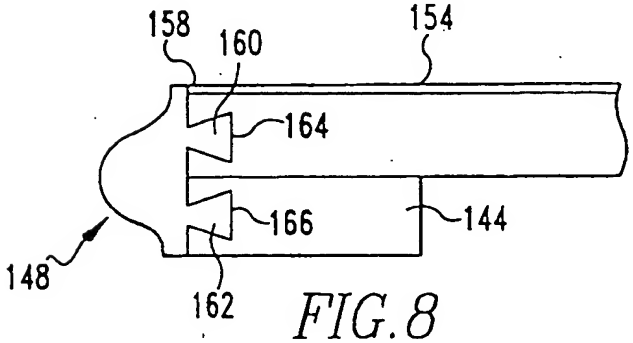

FIG. 8

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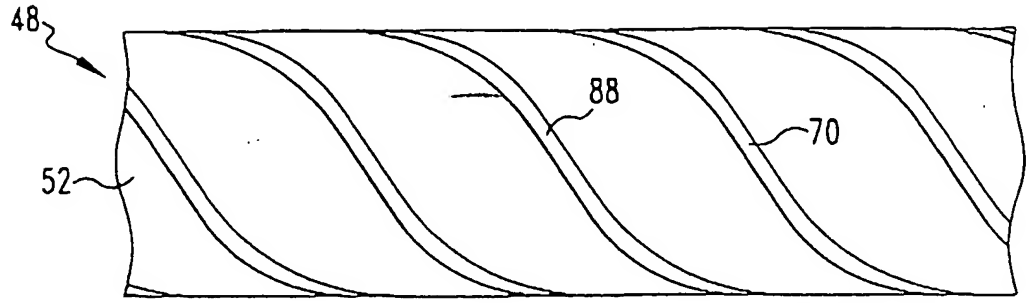

FIG.9

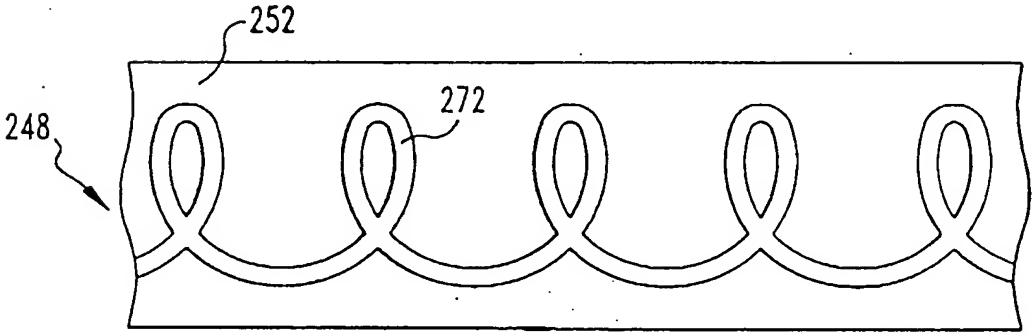

FIG.10

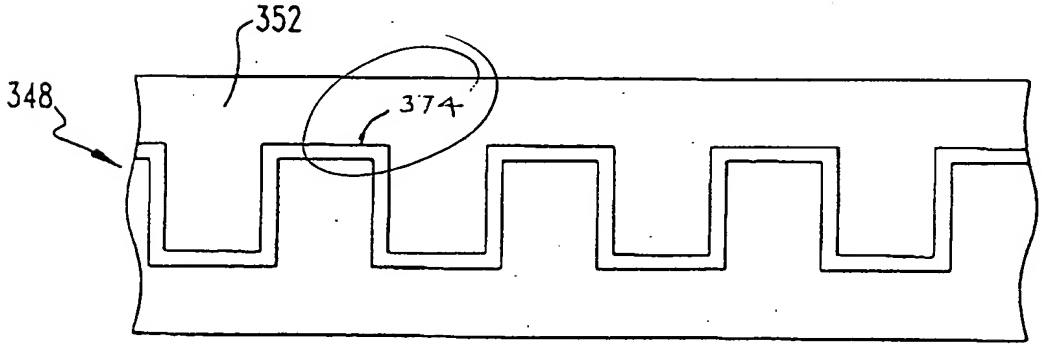

FIG.11

"Annotated Marked-up Drawings"